

AF/2837
JZW



Corres. and Mail
BOX AF

PATENT APPLICATION

**RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2837**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shoichi SASAKI

Group Art Unit: 2837

Application No.: 09/885,676

Examiner: M. Fletcher

Filed: June 21, 2001

Docket No.: 039628.99

For: POWER OUTPUT APPARATUS AND METHOD OF CONTROLLING THE SAME

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION
UNDER 37 C.F.R. §1.116**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action mailed September 21, 2004, reconsideration of the application is respectfully requested. Claims 7-9, 14, 16, 17, 19, 21, 24 and 25 are pending. The only ground for rejection cited in the Office Action is that all claims are rejected based upon a defective Reissue Declaration or Oath. The reasons are set forth in paragraph 2, on page 2 of the Office Action.

The Rejection is respectfully traversed. Firstly, filed herewith is a Substitute Reissue Declaration which expands upon the reasons Applicant believed the patent from which this Reissue was taken was partly inoperative by reason of failing to claim all that applicant had a right to claim.

37 C.F.R. §1.175(a) only requires that the Declaration or Oath, in addition to complying with the requirements of 37 C.F.R. §1.63, also state that applicant believes that the original patent is wholly or partly inoperative or invalid by reason of. . . claiming more or less than the patentee had a right to claim and stating at least one error being relied on as the basis for reissue; that all the errors up to the time of filing of the Oath or the Declaration occurred without any deceptive intention on the part of the applicant; and that at any time an error is first addressed during prosecution, a substitute Declaration is required.

In reply to the Office Action mailed March 22, 2004, Applicant submitted a Supplemental Oath identifying at least one error being relied upon as the basis for Reissue as is required. The Final Office Action issued September 21, 2004 stated that the Supplemental Declaration was insufficient because the Patent Office believed that an existing claim in the Reissue Declaration appeared to cover all of the features of a method drawn to claims 8 and 17. Applicant had alleged as the at least one error he had not filed claims drawn to a method corresponding to such claims (claims 8 and 17), and such is the case.

Whether another claim had commensurate scope (as alleged in the Office Action) is not the issue and is not correct. The scope of the method claims corresponding to apparatus claims 8 and 17 have a different scope than does the method of claim 21 even though the Office Action alleged such is not the case. Although Applicant submits that the Supplemental Declaration filed July 9, 2004 was fully responsive and in compliance with 37 C.F.R. §1.175, the attached Supplemental Declaration provides greater specificity as to the method being claimed, which is clearly of different scope than that of claim 21. Thus, it is respectfully requested that the Rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 7-9, 14, 16, 17, 19, 21, 24 and 25 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff

Registration No. 27,075

Robert A. Miller

Registration No. 32,771

JAO:RAM/kap

Attachment:

Supplemental Reissue Declaration

Date: December 8, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--